

**Appl. No.: 10/060,767**

Art Unit: 3653

**REMARKS**

Reconsideration of the application, as amended, is respectfully requested.

**I. STATUS OF CLAIMS**

Claims 30, 31, 40-72 are pending in this application. Claim 31 was amended to more particularly point out and distinctly claim that which applicants regard as their invention. Claims 46, 49 and 66 were amended into independent format to include all of the limitations of the base claim, i.e. claim 30.

It is respectfully submitted that no new matter has been added by virtue of this amendment. Support for the amended claims are found throughout the specification as originally filed.

**II. 35 U.S.C. 112, Second Paragraph Rejections**

The Examiner rejected claim 59 under 35 U.S.C. 112, second paragraph as being indefinite on the grounds that the phrase "laser-like action" does not clearly define the feature the applicant is claiming.

In response, Applicants respectfully assert that based upon the disclosure of the present application, and in particular page 18, lines 13-17 of the present application, one skilled in the art reading claim 59 would clearly understand the phrase "laser-like action".

**III. 35 U.S.C. 103(a) REJECTIONS**

The Examiner rejected claims 30 and 31 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,291,002 to Agnew, et al. ("the Agnew Patent") in view of U.S. Patent No. 4,860,273 to Sawano, et al. ("the Sawano patent"). In the Office Action, the

Examiner alleges that the Agnew patent teaches all of the elements of method claims 30 and 31, with the exception of the step of “affixing a layer [or] material onto said mail piece on which the marking is affixed”. However, the Examiner states that the Sawano patent teaches “a layer that is transparent or substantially transparent in a non-stimulated state and that becomes reversibly non-transparent upon the application of a stimulus. Further, the Examiner takes the position that it would have been obvious to one skilled in the art to use the layer of the Sawano patent in the mail processing method of Agnew if one desired to arrive at the presently claimed invention recited in claims 30 and 31.

In response, Applicants respectfully assert that the present claimed invention, as recited in independent claims 30 and 31, is non obvious over the Agnew patent in view of the Sawano patent for several reasons set forth below. In this regard, claim 31 has been amended to further clarify that the indicia recording information is carried on a marking affixed upon said layer.

**A. NO MOTIVATION TO COMBINE**

First, there is no motivation provided by the prior art to make the proposed combination suggested by the Examiner. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation in the references themselves explicitly or implicitly to do so. **See MPEP 2143.01**

Neither the Agnew patent nor the Sawano patent teaches nor suggests making the proposed combination suggested by the Examiner.

First, the Agnew patent relates to the printing of machine readable markings on envelopes, for use in automatic postal sorting and similar machinery. More particularly, the method in agnew is directed to high volume mailers, such as banks or credit card companies which send out monthly statements and who wish to save on postal fees by eliminating a sorting step at the post office. The Agnew patent describes achieving the

above objectives by marking a correspondence ( e.g. customer statement) with the destination address of the customer in the form of an easily readable machine readable first code. The marked correspondence is then placed into a window envelope such that the first code is positioned within the window. Next, the first code is machine read at a read station. Lastly, the envelope containing the correspondence is passed along to a print station, wherein a machine readable second code corresponding to the first code and the destination address is printed onto the front of the envelope in accordance with the instructions received by computer means electrically coupled to the read out station.

Next, the Sawano patent relates primarily to methods and recording mediums for use therewith which allow one to be able to record, erase and/or partially rewrite information into or from information recording mediums such as optical discs, e.g. video tape, an audio tape, a flexible disc and a disc memory for large-capacity computer or large-capacity static image files. The recording, erasing and/or partially rewriting of information from or into the recording medium in the Sawano patent is accomplished via a change in phase between a transparent and an opaque state or vice versa of a recording layer or coating associated with the information recording medium, which is induced by a laser beam of high energy density.

Specifically, in Sawano for example a polymer blend of a recording layer or material is brought into contact with a light absorbing layer or material, and the light-absorbing material is irradiated with a laser beam. Under irradiation with the beam, the light-absorbing material absorbs energy of the beam and generates a heat. Upon Receipt of the heat, the polymer blend increases in its temperature to a temperature of above its cloud point to change in the phase condition, whereby the polymer blend turns opaque or transparent. Thereafter, the polymer blend is rapidly cooled to fix the irradiated area of the polymer blend in the opaque or transparent state. Thus, recording of information is performed.

Moreover, the polymer blend which has been partially changed in the phase condition can be returned to its original state in the irradiated area (recorded area) by the

process of again elevating a temperature of the polymer blend to a temperature of above the cloud point and then gradually cooling. By this operation, the whole polymer blend returns to its original transparent or opaque state, and the recorded information is erased. Partial erasure of the recorded information can be also performed by subjecting the aimed area of the polymer blend to the same erasing operation as described above.

As can be gleaned from the above, no motivation is provided to one skilled in the art by either the Agnew patent or the Sawano patent to make the Examiner's proposed combination. Namely as even conceded by the Examiner in the current Office Action, the Agnew Patent fails to hint or even suggest providing a recording layer and/or recording medium for recording media information therein, as described in the Sawano patent. Rather, the Agnew patent's disclosure is limited to printing information codes, such as bar codes directly onto mailing envelopes without the use of any intermediate or intervening surfaces. Thus, the Agnew reference itself fails to provide motivation to make the combination proposed by the Examiner.

Further, the Sawano patent likewise fails to provide motivation to one skilled in the art to make the Examiner's proposed combination. In particular, the Sawano patent has nothing to do with the processing of mail. The Sawano patent is completely silent regarding anything using its method and/or recording mediums for this purpose. Instead, as mentioned above the teaching of Sawano are directed to being able to record, erase and partially rewrite information into or from optical media devices such as optical discs, e.g. audio tape, video tape, a flexible disc, disc memory.

Moreover, one skilled in the art would additionally not be motivated to make the Examiner's proposed combination by modifying the mail processing method of Agnew with the method of Sawano because in the Agnew patent, the information or indicia (e.g. customers destination address), is to remain the same or constant throughout the mail processing method. As mentioned, the Agnew patent teaches, in its mail processing method, the printing of a first code with a particular customer's address onto a

correspondence to be mailed to that customer. This first code is then read by an electronic reader through a transparent window of an envelope and a second code corresponding exactly to the first code is then printed onto the envelope with the correspondence to be sent to the customer. In contrast, the Sawano patent is directed again to being able to alter or completely erase information after it is recorded in its recording layer based upon inducing a phase change between an opaque and transparent state of the recording layer using a laser and then applying a subsequent cooling step.

Further, since there is no motivation provided by either reference for making the Examiner's proposed combination, it appears that the Examiner is engaging in the use of improper hindsight in making this combination. The teaching or suggestion to make the combination must be found in the prior art, not in the applicants disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir. 1991)*. As for the Examiner's statement that the Sawano patent does teach that its layer can be affixed to recording media of various forms including cards and sheets, it is unclear what the terms "cards and sheets" are actually referring to in this patent. It appears however that the Examiner is attempting to use this terms mentioned in the Sawano patent to suggest that its method and recording layer can be applied to mail processing methods such those described in the Agnew patent. In any event, for the reasons already set forth herein, it is impractical to use the recording layer and methods of Sawano in the mail processing method such as described in the Agnew patent because the mail processing method of Agnew requires that the information or indicia remain exactly the same through its process, whereas the Sawano patent teaches be able to alter and/or erasing its information after it has been recorded.

**B. REFERENCES ARE NOT COMBINABLE**

Second, it is respectfully asserted that hypothetically even if there were motivation to combine these references that these references are not even combinable for reasons similar to those set forth above.

Again, the mail processing method of the Agnew patent requires that the

information or indicia remain exactly the same through its process, whereas the Sawano patent teaches being able to alter and/or erasing its information after it has been recorded. It is therefore evident that combining the Sawano patent with the Agnew patent as suggested by the Examiner, would require a substantial reconstruction and redesign of the elements shown in the Agnew patent as well as a change in the basic principle under which the Agnew patent construction was designed to operate. It is well known in patent law that a proposed modification cannot change the principle of operation of a reference. See MPEP 2143.01. Accordingly, the Agnew and Sawano patents are not combinable.

**C. REFERENCES EVEN IF COMBINABLE FAIL TO TEACH OR SUGGEST THE PRESENTLY CLAIMED INVENTION**

Finally, for the sake of argument, even if these references could be combined as suggested by the Examiner, this combination would still fail to teach each and every element of the presently claimed invention, as recited in independent claims 30 and 31.

In particular, at the very least this combination would at the very least fail to teach or suggest a method for processing mail wherein , the indicia or information is carried on a marking affixed upon the layer; as recited in independent claims 30 and independent claim 31, as amended. Rather, this combination would result in the mail sorting information of Agnew being recorded within the recording layer of Sawano and this information would be subject to partial or complete erasure by an induced phase change in the recording layer and subsequent cooling step. In contrast, the indicia or information in the presently claim invention as recited in independent claim 30 and in amended independent claim 31, is affixed upon the layer instead of being recorded within the layer itself and also the information carried on the marking is not subject to erasure or partial erasure .

Therefore, for all of the reasons set forth above, withdrawal of the Examiner's

rejection of claims 30 and 31 is respectfully requested.

The Examiner also rejected claims 40-42, 44, 45, 50, 51 and 64 under 35 U.S.C. 103(a) as being obvious over Agnew in view of Sawano as applied to claim 30 above, and further in view of Sawano.

As already stated herein, there is no motivation to make this proposed combination, these references are not combinable and even if it were possible to combine them, this combination would still fail to teach or suggest the presently claimed invention as recited in claim 30 and 31. Since 40-42, 44, 45, 50, 51 and 64 depend from and incorporate all of the limitations of independent claim 30, these claims are likewise patentable over the Examiner's proposed combination.

The Examiner also rejected claims 52-54, 62 and 65 under 35 U.S.C. 103(a) as being obvious over Agnew in view of Sawano as applied to claim 30 above, and further in view of Agnew.

Since claims 52-54, 62 and 65 depend from and incorporate all of the limitations of independent claim 30, these claims are also patentable over the Examiner's proposed combination for the reasons already set forth herein.

The Examiner also rejected claims 47 and 48 under 35 U.S.C. 103(a) as being obvious over Agnew in view of Sawano as applied to claim 30 above, and further in view of U.S. Patent No. 5,587,404 to Kroner et al. ("the Kroner patent").

As mentioned herein, there is no motivation to combine the Agnew patent and Sawano patents and these patents are not even combinable. Accordingly, claims 47 and 48 are patentable over the Examiner's proposed combination above.

Lastly, the Examiner rejected claims 43, 55-58, 60 and 63 under 35 U.S.C. 103(a) as being obvious over Agnew in view of Sawano as applied to claim 30 above, and

further in view of U.S. Patent No. 5,532,104 to Goto. ("the Goto patent").

As stated, there is no motivation to combine the Agnew patent and Sawano patents and these patents are not even combinable. Accordingly, claims 43, 55-58, 60 and 63 are patentable over the Examiner's proposed combination above.

#### **IV. ALLOWABLE SUBJECT MATTER**

Applicants acknowledge with appreciation, the Examiner's indication that claims 69-72 are allowed and that claims 46, 49, 61 and 66-68 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In order to expedite the prosecution of the present application, claims 46, 49 and 66 have been amended into independent format to include all of the limitations of the base claim, i.e. claim 30. Claims 46, 49 and 61 are thus in allowable format.

#### **V. CONCLUSION**

It is believed that all pending claims as currently presented are in condition for allowance. A notice of allowance is respectfully requested.

According to currently recommended Patent Office policy, the Examiner is requested to contact the undersigned at the telephone number provided below in the event that a telephone interview will advance the prosecution of this application. An early and favorable action is earnestly solicited.

Further, a check in the amount of \$122.00 is also enclosed herewith to cover the additional claims fee for the new total of six independent claims resulting from this



amendment. The applicant is a small entity and is thus entitled to the reduced fee. No other fees are believed due with this amendment. However, if there are any additional fees due, then please charge them to deposit account no.: 50-1924.

Respectfully submitted,

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#### CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date shown below.

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